

REMARKS

The Office Action mailed August 17, 2004, set a three-month period for response expiring November 17, 2004. Pursuant to the Petition for Extension of Time under 37 C.F.R. 1.136(a) submitted herewith, the period for response is extended one month to expire December 17, 2004. This amendment is therefore timely filed.

Claims 1-27 were in the application as originally filed. Claims 4, 6-7, 10, 12-15, 17-21, and 24-27 were cancelled and Claims 28-39 were added in the Preliminary amendment filed on September 16, 2003. Claims 1-3, 5, 8-9, 11, 16, 22-23, and 28-39 are in the application.

Restriction has been required under 35 U.S.C. § 121 as follows:

Group I: Claims 1-3, 5, 8, 9, 11, 16, 22, 23, 28, and 29, drawn to compounds of formula I and a process of making them, classified in class 544, 514, subclass, 360, 111, 253.01, 231.5.

Group II: Claims 30-34, drawn to different process of making compounds, classified in classes 544, 546, and in various subclasses.

Group III: Claims 35-39, drawn to different processes of using the compounds of a different scope, classified in classes 544, 546, 514 and various subclasses.

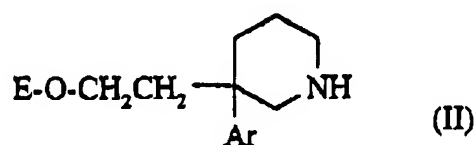
The provisional election of Group I made during a telephone conversation with Examiner Desai on August 11, 2004, is hereby affirmed. Claims 30-39 (Claims 30-34 from non-elected Group II, and Claims 35-39 from non-elected Group III) have been withdrawn from consideration as being drawn to a non-elected invention.

Claim 16 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention on the grounds that the claim recites O-protection group and functional derivatives, and it is not clear what these functional derivatives and groups are. The Examiner has indicated that this rejection can be overcome by inserting the groups described in the specification on pages 14 and 15.

This rejection is traversed and reconsideration and withdrawal thereof is respectfully requested for the reasons given hereinbelow.

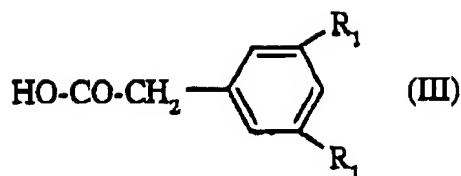
The legal standard of indefiniteness under 35 U.S.C. § 112, second paragraph, is whether a claim reasonably appraises those of skill in the art of its scope. In this regard, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Claim 16 is directed to a process for preparing a compound of formula I. One of the intermediates in the process of Claim 16 is a compound of Formula II:



in which E can either be a hydrogen or an O-protecting group. The specification indicates that O-protecting groups of the invention are conventional O-protecting groups ("O" generally recognized by those of skill in the art as oxygen), which are well known to those skilled in the art. Examples of such O-protecting groups are listed on page 14 of the specification. One of ordinary skill in the art upon reading the claims in light of the specification *and* in light of the teachings of the prior art, and not in a vacuum, would understand what conventional oxygen protecting groups are without the recitation of specific oxygen protecting groups within Claim 16. In fact, the Examiner has provided no evidence that those of ordinary skill would not be apprised of such conventional O-protecting groups. Therefore, the rejection of the term "O-protecting group" in Claim 16 as being indefinite is believed unwarranted, and withdrawal thereof is respectfully requested.

With respect to the rejection of the expression "functional derivative" in Claim 16, Applicants submit that there is no ambiguity or indefiniteness in the claim due to the phrase "functional derivative." The process of Claim 16 includes treating a compound of formula II with a functional derivative of an acid of formula (III):

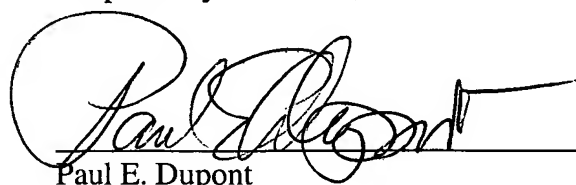


The specification (p. 14-15) describes that functional derivatives of the acid of formula III can be either the acid itself or a functional derivative of the acid which reacts with amines. Again, numerous examples of functional derivatives are provided on pages 14 to 15 and include an anhydride, a mixed anhydride, acid chloride, and an activated ester. The Examiner has not indicated that a functional derivative of an acid which reacts with an amine would be unclear to those of skill in the art. Accordingly, Claim 16 read in light of the specification *and* in light of the teachings of the prior art is neither unclear nor indefinite, and the phrase "functional derivative of an acid" would be understood to those of skill in the art without the recitation of specific examples of the functional derivatives within Claim 16. Therefore, the rejection of the phrase "functional derivative" in Claim 16 as being indefinite is believed unwarranted, and withdrawal thereof is respectfully requested.

Claims 30-39 which stand withdrawn from consideration as drawn to non-elected subject matter are hereby cancelled without prejudice to the prosecution thereof in a continuing application.

There being no remaining issues, this application is believed in condition for favourable reconsideration and allowance of Claims 1-3, 5, 8-9, 11, 16, 22-23, and 28-29 and such action is earnestly solicited.

Respectfully submitted,



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